



REMARKS

Claims 1-10 and 17-20 are pending in this application. As recited therein, the present invention relates generally to disposable police restraints (handcuffs), of both the single loop variety and the double loop variety.

Specifically, the present invention is directed to a method and apparatus for coiling such cuffs, which are normally carried in their open configuration, or in a partially closed loop, into a small, easy to carry, and easy to use, coiled cuff form. Other embodiments of the present invention are the coiled disposable cuffs themselves, both in the single loop form and the double loop form.

The term "coiled" as defined in the specification as filed (see page 3) describes a wound version, preferably a tightly wound version, of the strap portion of the cuff device, wound in a clockwise and/or counterclockwise manner, to significantly reduce the size of the cuff, and to permit easy carrying of the same. In the single loop form, the socket can be wound inside the strap, or the strap can be wound leaving the socket on the outside of the coil. In the double loop form, the two straps are normally wound separately, such that the coils are gathered under the central socket member. Applicant submits that the term "coil" as used herein, is used in its ordinary and customary manner. See for example Webster's Dictionary definition:

coil (verb) - to wind into rings or spirals...

coil (noun) - a series of loops; spiral; a single loop of such a coil...

Clearly, the term "coiled" means wound into a "circular coil" and not a folded orientation. The prior art "folded" versions of such cuffs have been addressed in the specification as failed attempts at making such devices easier to carry.

The claims have been amended to correct minor typographic errors and to provide proper antecedent basis. No new matter has been added by virtue of the amendments made to the claims.

At page 2 of the Office Action, the Examiner has rejected claims 9 and 19 under 35 U.S.C. § 112 as being indefinite because the phrase “at one about” is unclear. Applicant respectfully submits that claims 9 and 19 have been amended to recite “at about,” thus obviating the Examiner’s rejection.

At page 2 of the Office Action, the Examiner has rejected claims 17 and 19 under 35 U.S.C. §102(b) as being anticipated by Robinson, U.S. Patent No. 5,443,155. The Examiner asserts that “Robinson (figures 8 and 9) teaches coiled tooth strap structure which is coiled and in a package. Figure 8 shows the two coiled strap version and figure 9 shows the single coiled strap version.” Applicant respectfully traverses this rejection.

It is axiomatic that for a cited document to constitute an anticipation, all of the material elements of a claim must be found in the cited document. See for example, *In re Marshall*, 577 F.2d 301, 198 USPQ 344 (CCPA 1978); and *In re Kalm*, 378 F.2d 959, 154 USPQ 10 (CCPA 1967).

As reaffirmed by the Court of Appeals for the Federal Circuit in *Kalman v. Kimberly Clark Corp.*, 713 F.2d 760 at 771, 218 USPQ 781 at 789 (Fed.Cir. 1983), *cert. denied*, 104 S.Ct. 1284 (1984):

A party asserting that a patent claim is anticipated under 35 U.S.C. §102 must demonstrate, among other things, identity of invention. In cases like this, identity of invention is a question of fact . . . and one who seeks such a finding must show that each element of the claim in issue is found, either expressly described or under principles of inherency,

in a single prior art reference, or that the claimed invention was previously known or embodied in a single prior art device or practice.

(citations omitted)

See also, *Tyler Refrigeration v. Kysor Industrial Corp.*, 777 F.2d 687, 227 USPQ 845 (1985) and compare *Kloster Speedsteel AB v. Crucible, Inc.*, 793 F.2d 1565, 230 USPQ 81 (Fed.Cir. 1986).

Applicant's claims 17 and 19 are directed to a handcuff comprising a single **coiled** toothed strap with a single slot, toothed socket clasp at one end, and two **coiled** toothed straps and a two slot, toothed socket clasp at about the midpoint, respectively. Nothing in the Robinson patent teaches or suggests the claimed invention - which relies upon the definition of the word **coiled** that Applicant provided in the specification. Moreover, in that definition, Applicant expressly excluded the "looping" of the straps as when these straps are used as restraints. That language from page 3 of the specification reads as follows:

Insertion of the strap(s) into the socket(s) during use of the disposable cuffs, *thereby forming one or more loose loops, which are to be tightened during use*, is specifically excluded from the definition of the term "coiled" as used herein. (emphasis added)

Figure 8 of the Robinson reference teaches two strap parts (122 and 124) attached to slotted enlargements (134). Figure 9 of the Robinson reference depicts a single strap (106 or 108) attached to a slotted opening (110). The figures cited by the Examiner fail to teach a toothed socket clasp at one end of a single strap, or a toothed socket clasp at about the midpoint of a double strap, as claimed by Applicant. As the Robinson reference fails to teach all of Applicant's claim limitations, Applicant respectfully requests that this rejection be reconsidered and withdrawn.

At page 3 of the Office Action, the Examiner has rejected claim 17 under 35 U.S.C. §102(b) as being anticipated by Parsons, U.S. Patent No. 5,669,110. The Examiner asserts that “Parsons (figure 2) teaches single toothed strap resistant structure which is folded. However, folded is a form of sinusoidal planar coils.” The Examiner has also rejected claim 19 under 35 U.S.C. §102(b) as being anticipated by Burkholder, U.S. Patent No. 5,088,158. The Examiner asserts that “Burkholder (figure 5) teaches single toothed strap resistant structure which is folded. However, folded is a form of sinusoidal planar coils.” Applicant respectfully traverses these rejections.

As discussed above, folded restraint devices are specifically excluded from the definition of **coiled** as used herein by the Applicant. Accordingly, these two Section 102(b) rejections should be reconsidered and withdrawn.

Claims 17 and 19 are directed to a handcuff comprising a single **coiled** toothed strap, and two **coiled** toothed straps, respectively. At page 3, line 10 of the instant specification, Applicant defines the term “**coiled**” as wound in a clockwise and/or a counterclockwise manner. Applicant respectfully directs the Examiner’s attention to Figures 7B and 8B of the instant application, which illustrate the claimed single loop cuff and double loop cuff in their coiled forms. The references cited by the Examiner fail to teach or suggest a **coiled** strap as claimed by Applicant. These references instead teach “S” shaped curves. As Parsons and Burkholder fail to teach all of Applicant’s claim limitations, Applicant respectfully requests that this rejection be reconsidered and withdrawn.

At page 3 of the Office Action, the Examiner has rejected claims 1-10 under 35 U.S.C. §103(a) as being obvious over Peden, U.S. Patent No. 5,469,813, in view of Robinson, U.S. Patent No. 5,443,155, and Arthur, U.S. Patent No. 1,797,539. The Examiner asserts that “It would have been obvious

to modify the teachings of Peden to select a toothed strap to coil in view of Robinson teaching that it is well known to package coiled toothed restraints and to use a binding device rather than the kit of Robinson would have been obvious in view of Arthur teaching the well known use of rubber bands for securing coiled material.” Applicant respectfully traverses this rejection.

A critical step in analyzing the patentability of claims pursuant to section 103(a) is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. *See Dembiczak*, 175 F.3d at 999, 50 USPQ2d at 1617. Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one “to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher.” *Id.* (quoting *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983)).

Most if not all inventions arise from a combination of old elements. *See In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998). Thus, every element of a claimed invention may often be found in the prior art. *See id.* However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. *See id.* Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant. *See In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

The motivation, suggestion or teaching may come explicitly from

statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved. *See Dembiczak*, 175 F.3d at 999, 50 USPQ2d at 1617. In addition, the teaching, motivation or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. *See WMS Gaming, Inc. v. International Game Tech.*, 184 F.3d 1339, 1355, 51 USPQ2d 1385, 1397 (Fed. Cir. 1999).

Claim 1 and the claims depending therefrom are directed to a method of forming a compact disposable police restraint comprising: selecting a cuff device comprising at least one elongated, substantially flat strap, connected to a toothed socket clasp; rolling the flat strap of the cuff device into a coil; and securing the coil with a banding device.

The Peden reference teaches a restraint comprising a long, flexible tether for securing legs and feet behind someone's back. The Examiner admits that this reference fails to teach a toothed socket clasp or securing the coil with a banding device. Moreover, the fact that Figure 2 of Peden shows a "coil" form of the object, does not render the method of Claims 1-10 obvious. There is no "band" used to secure the Peden coil, as the sheer size thereof would prevent the effective use of a banding device.

The Robinson and Arthur references fail to cure the deficiencies of Peden. Nothing in Robinson teaches or suggests step (b) of the process of claim 1, namely "rolling the flat strap of the cuff device into a **coil**." (as that term is defined herein. The Robinson reference simply teaches two strap parts (122 and 124) attached to slotted enlargements (134). Figure 9 of the Robinson reference depicts a single strap (106 or 108) attached to a slotted opening (110). The figures cited by the Examiner fail to teach an essentially flat strap connected to a toothed socket clasp, let alone securing the cuff device with a banding device, as claimed by Applicant.

The Arthur reference teaches the use of a flexible band with a flexible handle to keep film on a reel. In other words - a rubber band is used to hold film on a reel. This reference fails to teach or suggest any kind of restraint or cuff device comprising a flat strap connected to a toothed socket clasp, let alone rolling a cuff device into a coil, as claimed by Applicant.

What motivation is present in these there prior art patents to support the proposed combination thereof? Only two references relate to restraint devices, but while Robinson teaches a cuff device, Peden teaches a restraint used to hog-tie a prisoner. These are very different types of restraints - used in very different situations. Arthur teaches that film on a reel can be held in place by a rubber band. That reference is totally irrelevant.

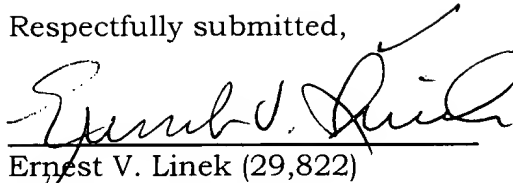
As none of the references teach the method of forming the restraint claimed by Applicant, the combination of references fails to teach each and every element of Applicant's invention. Accordingly, Applicant respectfully request that this rejection be reconsidered and withdrawn.

Attached hereto is a marked-up version of the changes made to the specification and claims by the current amendment. The attached page is captioned "Version with markings to show changes made."

Should the Examiner wish to discuss any of the amendments and/or remarks made herein, the undersigned attorney would appreciate the opportunity to do so. Thus the Examiner is hereby invited to call the undersigned, collect at the number shown below.

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Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Ernest V. Linek", written over a horizontal line.

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**VERSION WITH MARKINGS TO SHOW CHANGES
MADE**

IN THE CLAIMS:

9. (Amended) The method of claim 1, wherein the cuff device comprises two substantially flat, toothed straps and a two slot, toothed socket clasp at [one] about the midpoint of said straps.

19. (Amended) A disposable handcuff comprising two coiled toothed straps and a two slot, toothed socket clasp at [one] about the midpoint of said straps.